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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,556	10/28/2005	Ali Erdemir	051583-0318	5762
27433 7590 04/28/2009 FOLEY & LARDNER LLP 321 NORTH CLARK STREET SUITE 2800 CHICAGO, IL 60654-5313				
EXAMINER				
GOLOBOY, JAMES C				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
04/28/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/532,556

**Applicant(s)**

ERDEMIR ET AL.

**Examiner**

James Goloboy

**Art Unit**

1797

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2009.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24, 30-37, 44, 47-51 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 47-49 is/are allowed.  
6) ☒ Claim(s) 24, 30-37, 44, 50 and 51 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Applicant's amendment filed 4/8/09 does not overcome some of the rejections set forth in the office action mailed 1/8/09, which are maintained below. The rejection over Erdemir in view of Klyuchnikov and Orozco has been additionally applied to claim 31. The newly added claims are also rejected.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/8/09 has been entered.

***Claim Rejections - 35 USC § 103***

3. Claims 24, 30, 35, 44, and 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erdemir in view of Camezind.

The rejections of claims 24, 30, 35, 44, and 50-51 are adequately set forth in paragraph 2 of the office action mailed 1/8/09, which is incorporated here by reference. In column 4 lines 22-23 Camezind teaches that the base lubricant can be a mixture of polyalkylene glycol with water. While Camezind does not explicitly disclose dissolving the boric acid in the polyalkylene glycol before adding water, case law holds that the

selection of any order of mixing ingredients is *prima facie* obvious. *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930). Claims 50-51 are therefore rendered obvious.

4. Claims 32-33 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erdemir in view of Camezind as applied to claims 24, 30, 35, 42, and 44 above, and further in view of Orozco.

This rejection is adequately set forth in paragraph 4 of the office action mailed 1/8/09, which is incorporated here by reference.

5. Claims 24 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erdemir in view of Klyuchnikov and Orozco.

This rejection is adequately set forth in paragraph 5 of the office action mailed 1/8/09, which is incorporated here by reference.

***Allowable Subject Matter***

6. Claims 47-49 are allowed. The prior art does not teach dissolving boric acid in a solvent as recited in claim 47 and then adding the boric acid solution to a forming or machining fluid as recited in claim 47. Hall, as discussed in previous office actions, discloses dissolving boric acid in methanol prior to dissolving in water, but does not provide any reason to one of ordinary skill in the art to dissolve boric acid in methanol prior to adding to one of the claimed fluids.

### ***Response to Arguments***

7. Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that the concentrate of Erdemir only refers to a dispersion rather than a solution, and that example 2 of Erdemir teaches away from the concentrate of claim 30. However, Erdemir's example 2 only teaches away from a concentrate of boric acid in water, which is further dissolved in oil. As discussed in the previous office action, Erdemir also teaches that the base lubricant can be a non-aqueous solvent. Erdemir does not teach away from concentrates using a non-aqueous solvent as the base.

Applicant argues that the combination of Orozco with Erdemir "leaves a person with a combination of an oil of grease...". However, as stated above, the base lubricant of Erdemir and Camezind can be a non-aqueous solvent, such as those recited in the claims, which can be coated by the method of Orozco.

Applicant argues that Erdemir and Orozoco are improperly combined with Klyuchnikov because "the compositions of Klyuchnikov are complete in an of themselves". However, the Klyuchnikov reference is used to teach suitable non-aqueous base lubricants for the compositions of Erdemir, and proper motivation for combining has been set forth in the previous office action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/  
Acting SPE of Art Unit 1797